REMARKS/ARGUMENTS

The Office Action mailed May 21, 2004 has been carefully considered. Reconsideration

in view of the following remarks is respectfully requested.

Claims 1, 17, and 22 have been amended to further particularly point out and distinctly

claim subject matter regarded as the invention. Support for these changes may be found in the

specification, page 12, lines 4-21. The text of claims 8-12, 18-21, and 23-31 is unchanged, but

their meaning is changed because they depend from amended claims.

The 35 U.S.C. § 103 Rejection

Claims 7-12 and 17-31 were rejected under 35 U.S.C. § 103(a) as being allegedly

unpatentable over Yalcinalp[1] in view of Lipkin,[2] among which claims 7, 17 and 22 are

independent claims. This rejection is respectfully traversed.

According to the Manual of Patent Examining Procedure (M.P.E.P.),

> To establish a *prima facie* case of obviousness, three basic criteria must be met. First
> there must be some suggestion or motivation, either in the references themselves or in the
> knowledge generally available to one of ordinary skill in the art, to modify the reference
> or to combine reference teachings. Second, there must be a reasonable expectation of
> success. Finally, the prior art reference (or references when combined) must teach or
> suggest all the claim limitations. The teaching or suggestion to make the claimed
> combination and the reasonable expectation of success must both be found in the prior
> art, not in the applicant's disclosure.[3]

The Office Action states that "[t]he following set of rejections regarding claims 7, 17, and

22 are based upon the Examiner's interpretation of "and/or" equal "or". The Office Action

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[1] U.S. Patent 6,507,857
[2] U.S. Patent 6,721,747
[3] M.P.E.P § 2143.

further states that "Yalcinalp teaches a method for a user to interface with a workflow server *(fig. 2)*, including: accepting a task form from the user, the task form containing data tags and/or process tags, the data tags identifying persisted and non-persisted data component *(sic) (receiving a request for an input document...having tags associated with the input document, wherein one of the tags presents an external component, processing tags*; col.2, lines 23-48)".

Applicant takes these two statements to mean that the Patent Office is interpreting claim 7 in a way that ignores the persisted vs. non-persisted distinction in the claims, because the distinction is provided on only one side of an "or" statement. If Applicant is understanding this right, then this explains the resistance by the Patent Office to addressing the arguments made by the Applicant in response to the Office Action of July 31, 2003 regarding how the Yalcinalp reference fails to teach a distinction between persisted and non-persisted components.

Claims 7, 17, and 22 have been amended to remove the "or" aspect of the "and/or" statement. Applicant therefore respectfully maintains that the arguments made in the previous responses are now applicable. Namely, Yalcinalp fails to teach or suggest "accepting a task form from the user, said task form containing data tags and process tags, said data tags identifying persisted and non-persisted data components." There is no indication anywhere in Yalcinalp regarding task forms, nor is there any indication that it handles persisted vs. non-persisted data components. As stated before, there is no reason for Yalcinalp to consider these things, as the data inside the document is not relevant to Yalcinalp, it is the transformation of the document itself that is sought. Yalcinalp simply doesn't care about the substance of the content in the document, and thus does not care whether or not it is in a task form, persisted, or non-persisted.

Applicant therefore respectfully maintains that claims 7, 17, and 22 are now in condition for allowance.

As to dependent claims 8-12, 18-21 and 23-31, the argument set forth above is equally applicable here. The base claims being allowable, the dependent claims must also be allowable.

In view of the foregoing, it is respectfully asserted that the claims are now in condition for allowance.
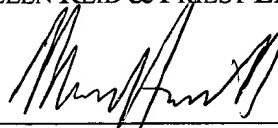
Conclusion

It is believed that this Amendment places the above-identified patent application into condition for allowance. Early favorable consideration of this Amendment is earnestly solicited.

If, in the opinion of the Examiner, an interview would expedite the prosecution of this application, the Examiner is invited to call the undersigned attorney at the number indicated below.

Applicant respectfully requests that a timely Notice of Allowance be issued in this case.

Please charge any additional required fee or credit any overpayment not otherwise paid or credited to our deposit account No. 50-1698.

Respectfully submitted,
THELEN REID & PRIEST LLP

Dated: 8/2/04

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